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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,089	10/29/2003	Suzanne M.K. Taussig	6032P720	6642
23504	7590	08/10/2005	EXAMINER	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,089

Applicant(s)

TAUSSIG ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 and 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to Applicant's amendment filed 7/18/2005.

Status of Claims

- [1] Claims 21-31, 48-51 are pending.

Claim Rejections - 35 USC § 102

- [2] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- [3] Claims 21-31, 48-51 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Shiman, US-1,040,791, because the invention was patented or described in a printed publication

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in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 21, Shiman teaches of a mounting for a jewel comprising:

a post (10) having a bouquet insertion end (bottom of 10) and a display end (top of 10 adjacent 14), said post (10) dimensioned [to be inserted into a bouquet of flowers] with said bouquet insertion end (bottom of 10) being proximate stems of said flowers while at the same time said display end (top of 10 adjacent 14) proximate said flowers [Shiman states in col. 1 beginning with line 8 that, "This invention relates to settings for diamonds and other gems, whether for ring, brooches, stick pins, earring or other uses" It is readily apparent to one skilled in the art of jewelry that such dimensions of the instant invention by Shiman can be used for placement in bouquet of flowers. It is also readily apparent that in doing so, the length of the post may be manipulated to account for a certain size post to correspond directly with that of a specific length of flowers as to have the gem mounting properly displayed.]

at least one setting (14) coupled in a substantially perpendicular orientation to said post (10) proximate said display end (top of 10 adjacent 14), said at least one setting (14) defining:

an open bottom (either inside of 12 in Fig. 1; 19 in Fig. 2; or inside of 30 in Fig. 4, and further from col. 2, beginning with line 57, "In both forms o the setting, an open space is left at the center for the admission of light.") exposing an underside of said at least one jewel (40);

a plurality of apertures (to the right and left of 12) exposing all sides of said at least one jewel (40); and

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a plurality of prongs (12) for securing said at least one jewel (40) within at least one setting (14), said prongs (12) extending in a substantially upward and substantially perpendicular direction; and

at least one jewel (40) [dimensioned to be secured into] said at least on setting (14) and dimensioned to be coupled in a substantially perpendicular orientation to said display end of said post (top of 10 adjacent 14).

Examiners note: [] is an example of intended use, as it fails to further limit the structure of the claimed invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claims 22-25, (column 1, line 8, “for diamonds and other gems”).

Re: Claim 26, wherein said post (10) being comprised of metal.

Re: Claim 27, wherein said post being gold plated (It would have been an obvious matter of art recognized equivalence to have a variation gold plated, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Shiman).

Re: Claim 28, wherein said post being silver plated (It would have been an obvious matter of art recognized equivalence to have a variation silver plated, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Shiman).

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Re: Claim 29, wherein said post (10) having a length of between approximately 4-6 inches and a diameter of between approximately 2-3 millimeters.

Re: Claim 30, wherein a bottom portion of said at least one setting (14) being soldered to said post (10) proximate said display end (adjacent 14) (Examiner takes official notice that it is old and well known to use the technique of soldering to combine two different pieces of metal together. Therefore, though Shiman does not explicitly state such, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have used a soldering technique.

Re: Claim 31, further comprising at least one earring back (14), said earring back (14) defining a bore therethrough and dimensioned to be slidably coupled around said post (10) proximate said display end (14), said earring back having a top portion being coupled to said open bottom of said at least one setting (14).

Re: Claim 48, wherein said post (10) being at an offset position relative to said at least one jewel (40).

As for Claim 49, Shiman teaches of a mounting for a jewel comprising:

a post (10) having a bouquet insertion end (bottom of 10) and a display end (top of 10 adjacent 14), said post (10) dimensioned [to be inserted into a bouquet of flowers] with said bouquet insertion end (bottom of 10) being proximate stems of said flowers while at the same time said display end (top of 10 adjacent 14) proximate said flowers [Shiman states in col. 1 beginning with line 8 that, "This invention relates to settings for diamonds and other gems, whether for ring, brooches, stick pins, earring or other uses" It is readily apparent to one skilled in the art of jewelry that such dimensions of the instant invention by Shiman can be used for

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placement in bouquet of flowers. It is also readily apparent that in doing so, the length of the post may be manipulated to account for a certain size post to correspond directly with that of a specific length of flowers as to have the gem mounting properly displayed.]

at least one setting (14) coupled in a substantially perpendicular orientation to said post (10) proximate said display end (top of 10 adjacent 14), said at least one setting (14) defining an open bottom (either inside of 12 in Fig. 1; 19 in Fig. 2; or inside of 30 in Fig. 4, and further from col. 2, beginning with line 57, "In both forms of the setting, an open space is left at the center for the admission of light.") exposing an underside of said at least one jewel (40); and

at least one jewel (40) [dimensioned to be secured into] said at least one setting (14) and dimensioned to be coupled in a substantially perpendicular orientation to said display end of said post (top of 10 adjacent 14).

Re: Claim 50, wherein said setting (14) being substantially crown-shaped.

Re: Claim 51, wherein said setting defining a plurality of apertures (adjacent 12) exposing all sides of said at least one jewel (40).

Response to Arguments

[4] Applicant's amendment, see amendment and remarks filed 7/18/2005, with respect to the rejection(s) of claim(s) 1-6, 8, 21-31 under Paye, US-1,777,893, have been fully considered. Therefore, the rejection with regard to claims 1-6, 8, and 21-31 has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Shiman, US-1,040,791. Thus, in view of new grounds of rejection, the arguments to Paye are considered moot.

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Conclusion

[5] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


[6] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. **Until July 14th, the fax phone number for the organization where this application or proceeding is assigned is 703-872-9306; starting July 15th, however, the new fax phone number will be (571) 273-8300, please make note.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR


ROBERT J. SANDY
PRIMARY EXAMINER